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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,718	07/16/2003	Joseph L. Tallal JR.	GM2:1006	9581
34725	7590	06/25/2008		
CHALKER FLORES, LLP			EXAMINER	
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DALLAS, TX 75234			ART UNIT	
			PAPER NUMBER	
			3626	
			MAIL DATE	
			DELIVERY MODE	
			06/25/2008	
			PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/620,718

Applicant(s)

TALLAL, JOSEPH L.

Examiner

SHEETAL R. RANGREJ

Art Unit

3626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-26 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-26 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02/04/2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Prosecution History Summary

- Claims 1 and 27 are cancelled.
- Claims 2-26 and 28-30 are pending.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 2-23, 24-26, 28-30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-23 and 26-28 of copending Application No. 10/620, 904. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations from the claims of U.S. Application 10/620,718 are covered in the claims of U.S. Application No. 10/620, 904.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 2-7, 10-18, 21-23, 24-26, and 28-30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-7, 8-16, 17-19, and 20-22 of copending Application No. 10/620, 903. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations from the claims of U.S. Application 10/620,718 are covered in the claims of U.S. Application No. 10/620, 903.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Applicant has indicated that the rejection will be addressed through amendment, cancellation, or terminal disclaimer.

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "212" (fig. 2A) and "712" (fig. 7) have been used to designate "discount price". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 24, 2-10, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Care Entrée (<http://web.archive.org/web/200102025005600/careentree.com>, 2001) in view of Lipton, et al ("Pharmacy benefit management companies: Dimensions of performance", Annual Review of Public Health. Palo Alto: 1999. Vol. 20, p. 361), further in view of Goch ("A New Card Deal." Best's Review. Oldwick: July 2002. Vol. 103 (3); p. 73).
4. As per claim 24, the Care Entrée program teaches a method for receiving a membership fee from one or more individuals to become members of the health care plan (p. 3, para. 10) and

participate via incentives within a member multi-level marketing network (p. 2, para. 8-9). The Care Entrée program also teaches obtaining information from one or more medical service/good providers that have joined the health care plan (p. 8, para. 41) and providing a discount price list and the medical service/good provider listing to the member (p. 8, para. 41).

The Care Entrée program does not teach a method that regulates the cost of services/goods provided to the members by the medical service/good providers such that the members pay the medical service/good providers in-full directly for any services/goods rendered to the members based on the discount price list, and wherein the medical service/good provider listing comprises basic listing and premium listings for the medical service/good providers.

Lipton et al. teaches a system comprising a method that regulates the cost of services/goods provided to the members by the medical service/good providers (para. 30) and wherein the medical service/good provider listing comprises basic listing and premium listings for the medical service/good providers (para. 7, 41-45, and 111).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of the Care Entrée program with Lipton et al. with the motivation of managing medical costs and services (para. 32-34). This is accomplished by a pharmacy manager via drug enrollments reports/physician prescription history and rebates from the drug manufacturer. This can be equated to a network provider in that the network provider takes the information and generates data pertaining to which medical services are most frequently prescribed or ordered, and uses this information to negotiate a discount on that particular service and/or medication.

Lipton fails to explicitly teach a method such that the members pay the medical service/good providers in-full directly for any services/goods rendered to the members based on the discount price list.

Goch teaches a method such that the members pay the medical service/good providers in-full directly for any services/goods rendered to the members based on the discount price list (para. 20).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Care Entrée program with Lipton et al. and Goch with the motivation of ensuring a discounted cost for medical services (Goch: para. 18).

5. As per claim 2, the Care Entrée program fails to teach a method wherein the discount price list is a variable discount price list that tracks a known standard service/good price list.

Lipton et al. teaches a system in which the discount price list is a variable discount price list that tracks a known standard service price list (paragraph 7). This is accomplished through the use of negotiated discounts with pharmacy networks, as well as controlling the formularies used by the pharmacy benefit manager (i.e. the pharmacy benefit manager chooses which drugs to include in the formulary, thereby lowering the cost of the pharmaceuticals). This same method can be applied to a list of services provided by a medical provider, wherein negotiated discounts are applied to medical providers, hospitals, hearing, vision, etc. It can be assumed that lists are required to provide network provider with the recent price list, as well as the discounted price list.

The motivation to combine the teachings is discussed in claim 24.

6. As per claim 3, the Care Entrée program teaches a method wherein the membership fee is paid by the individual (p. 3, para. 10). The Care Entrée program discloses a method in which anyone can pay a certain fee to join a health care plan.

7. As per claim 4, the Care Entrée program teaches a method in which the membership fee is paid by the individual's employer (page 12, paragraph 67).

8. As per claim 5, the Care Entrée program teaches a method in which the membership fee is paid by the individual's business (page 12, paragraph 67). The examiner interprets an individual's employer, in this case, to be equivalent to an individual's business. In either case, the individual is provided the opportunity to offer employees (including self) a supplemental health care plan.

9. As per claim 6, the Care Entrée program teaches a method wherein the membership fee is a renewal fee (page 2, paragraph 6). The examiner interprets the monthly fee to be a renewal fee - the member is paying a renewal fee every month.

10. As per claim 7, the Care Entrée program teaches a method wherein the member can include his/her family in the health care plan (page 3, paragraph 10). The Care Entrée program allows the entire family (including all Internal Revenue Service dependents) to join the health care plan.

11. As per claim 8, the Care Entrée program teaches a method wherein the medical service/good providers are selected from the group consisting of physicians, hospitals, physical therapists, nursing facilities, cancer treatment centers, optical and hearing aid dispensaries, hospices, clinics, pharmacies, chiropractors, dentists, medical supply stores, hospital supply stores, and handicap equipment suppliers (page 11, paragraphs 61 - 63). Although physical

therapy, cancer treatment centers, and medical, hospital, and handicap supply stores are not specifically taught in the Care Entrée program, these services/providers can be included as ancillary services, as taught by the Care Entrée program (page 5, paragraphs 21 -23).

12. As per claim 9, the Care Entrée program teaches a method wherein the medical service/good provider is a doctor that works for a corporation (page 4, paragraph 16). The Care Entrée program refers to this as a PHCS (Private Health Care System).

13. As per claim 10, the Care Entrée program teaches a method comprising providing a medical service/good provider listing by the network provider to the members (page 12, paragraphs 68 and 69). The Care Entrée program provides a listing of common health care providers in certain area.

14. As per claim 28, the Care Entrée program teaches a method for receiving a membership fee from one or more individuals to become members of the health care plan (p. 3, para. 10). The Care Entrée program also teaches obtaining information from one or more medical service/good providers that have joined the health care plan (p. 8, para. 41) and participate via incentives within a member multi-level marketing network (p. 2, para. 8-9).

The Care Entrée program does not teach a method to provide a discount price list regulating the cost of services/goods provided.

Lipton et al. teaches a system comprising a method to provide a discount price list regulating the cost of services/goods provided to the members (para. 30). The examiner interprets the pharmacy benefit manager to be a similar function as the network provider in that it provides a discount on all health care needs.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of the Care Entrée program with Lipton et al. with the motivation of managing medical costs and services (para. 32-34). This is accomplished by a pharmacy manager via drug enrollments reports/physician prescription history and rebates from the drug manufacturer. This can be equated to a network provider in that the network provider takes the information and generates data pertaining to which medical services are most frequently prescribed or ordered, and uses this information to negotiate a discount on that particular service and/or medication.

15. Claims 11-23, 25-26 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Care Entrée in view of Lipton, et al. and Goch as applied to claim 24 above, and further in view of U.S. Patent No. 5, 819, 092 (Ferguson, et al.).

16. As per claim 11, the method of claim 10 as applied to claim 24, is taught by the Care Entrée program, in view of Lipton et al.

The Care Entrée program and Lipton et al. do not teach a method comprising basic and premium listings.

Ferguson et al. teaches a method wherein the medical service/good provider listing comprises basic listings and premium listings (column 7, lines 10 - 18 and column 13, lines 66 - 67 through column 14, lines 1 - 6). The examiner interprets basic and premium listings to be equivalent to a directory lookup service, as disclosed in Ferguson et al. The directory look up service can encompass a listing of people (i.e. physicians) and products (i.e. pharmaceuticals).

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method of basic and premium listings as taught by Ferguson

et al, with the motivation of providing a fast method of online searching directories (column 4, lines 18 - 20 and 41 - 43).

17. As per claim 12, the method of claim 11 as applied to claim 24, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a method wherein the basic listings are free of charge to medical services/good providers.

Ferguson et al. teaches a method wherein the basic listings are provided to medical service/good providers free of charge (column 13, lines 66 - 67 through column 14, lines 1 - 12). The examiner interprets the look up directory disclosed by Ferguson et al. to include a 'basic' listing - where a name, address and other related information is available.

The motivation for combining the teachings of the Care Entrée Program, Lipton et al., and Ferguson et al. is discussed in claim 11.

18. As per claim 13, the method of claim 11 as applied to claim 24, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a method wherein the premium listings are available to medical service/good providers for a fee.

Ferguson et al. teaches a method wherein the premium listings are provided to medical service/good providers upon payment of a premium listing fee (column 14, lines 6 - 12 and column 18, lines 33- 35). The examiner interprets the look up directory disclosed by Ferguson et al. to include a 'premium' listing - where a name, address and a hyperlinked document with other related information is available.

The motivation for combining the teachings of the Care Entrée Program, Lipton et al., and Ferguson et al. is discussed in claim 11.

19. As per claims 14, 15, and 16 as applied to claim 24, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a method wherein the premium listings are hyperlinked to a medical service/good providers web page.

Ferguson et al. teaches a method wherein the premium listings include a link to a customizable web page for the medical services/goods provider accessible via a global telecommunications network, wherein the premium listings include a link to the medical service/good provider's web site, and wherein the premium listings are customized for each medical Service/good provider (column 14, lines 6 - 19 and column 7, lines 37 - 42). The hyperlinks allow the user to access a site in which qualified users may submit new entries, thereby making it customizable.

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method of premium listings hyperlinked to a medical service/good providers web page (where the medical service/good provider can be equated to a pharmaceutical company) and is accessible to the global internet as taught by Ferguson et al. with the motivation of allowing a user to create online services using existing information (column 7, lines 1 -4).

20. As per claim 17, the method of claim 10 as applied to claim 24, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a method wherein the discount price list is available via a telecommunications network.

Ferguson et al. teaches a method wherein the discount price list and the medical service/good providers listing are accessible via a global telecommunications network (column 14, lines 2 - 6 and column 7, lines 37 - 42). The examiner interprets the discount price list to be a function of the directory look up disclosed by Ferguson et al. It provides information to users of a health care plan.

The motivation for combining the teachings of the Care Entrée Program, Lipton et al., and Ferguson et al. is discussed in claims 14, 15, and 16.

21. As per claim 18, the method of claim 10 as applied to claim 24, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a method wherein the discount price list is searchable by members of the health care plan.

Ferguson et al. teaches a method wherein the discount price list and the medical service/goods providers listing are searchable by the members using one or more search criteria (column 10, lines 62-65). Ferguson et al. discloses a method where users are allowed to perform searches, where they can specify the search criteria.

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method of searching a discount price list and medical service/goods providers listings as taught by Ferguson et al. with the motivation of enabling users to search listings or entries in a directory by a variety of techniques (column 14, lines 10-12), including names, categories, and full text searches.

22. As per claims 19 and 20, the Care Entrée program teaches a method wherein one of the search criteria is based on geographic area and one of the search criteria is based on the services provided by the medical service/good provider (page 12, paragraphs 68 and 69). The Care Entrée program provides a listing of common health care providers in certain area.

23. As per claim 21, the Care Entrée program in view of Lipton et al teaches the method of claim 1.

The Care Entrée program and Lipton et al. fail to explicitly teach a method wherein the network provider provides the advertisements to members.

Ferguson et al. teaches a method comprising one or more advertisements by the network provider to the members (column 14, lines 6 - 12 and column 14, lines 21 - 31).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method of placing online advertisements as taught by Ferguson et al. with the motivation of increasing the sales of a medical services/goods provider by use of advertisements in the discount price list by the network provider (column 9, lines 54 - 56). An online service can be used as a tool to enable electronic commerce. In this case, the online service would advertise services of medical professionals, hospitals and more.

24. As per claim 22, the method of claim 21 as applied to claim 24, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a method wherein the advertiser pays the network provider a fee for advertising.

Ferguson et al. teaches a method wherein an advertiser pays the network provider an advertising fee to provide the advertisements to the members (column 18, lines 33 - 35).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method of charging a fee to place advertisements as taught by Ferguson et al. with the motivation of creating an easy to use online service (column 10, lines 25 - 29) which can be used to generate revenue for a network provider by allowing a medical service/good provider to advertise on medical services/goods provider lists.

25. As per claim 23, the method of claim 21 as applied to claim 24, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a method wherein the advertisement is used to search the medical service/good provider listing.

Ferguson et al. teaches a method wherein the advertisement provided to a member is based on one or more search criteria used to search the medical service/good provider listing (column 14, lines 6 - 12). Searches can be made in directory look up's using names, categories or full text search techniques.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method of including advertisements when conducting a search of a medical service/good provider listing as taught by Ferguson et al. with the motivation of introducing a revenue generating tool by charging a fee for the online service (column 14, lines 30- 31).

26. As per claim 25, the Care Entrée program teaches receiving membership fees from individuals and participating via incentives within a member multi-level marketing network (para. 10), and obtaining information from one or more medical/service good providers that have joined the health care plan (para. 41).

Care Entrée fails to teach a computer program embodied on a computer readable medium executable by a server for providing health care plan comprising: a code segment for providing a discount price list and a medical/service/good provider listing to the members that regulates the cost of goods/services to members by the medical service/good providers such that the members pay the service/good providers in-full directly for any services/goods rendered to the members based on the discount price list, and wherein the medical service/good provider listing comprises basic listing and premium listings for the medical service/good providers.

Lipton teaches a discount price list and a medical/service/good provider listing to the members that regulates the cost of goods/services to members by the medical service/good providers such that the members pay the service/good providers in-full directly for any services/goods rendered to the members based on the discount price list, and wherein the medical service/good provider listing comprises basic listing and premium listings for the medical service/good providers (Lipton: para. 7, 41-45, and 111).

Lipton fails to teach a computer program embodied on a computer readable medium executable by a server and a code segment.

Ferguson teaches a computer program embodied on a computer readable medium (Ferguson: col. 3, 39-50) executable by a server (Ferguson: col. 7, 42-47) and a code segment (Ferguson: col. 2, 39-50).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention to combine the teachings of Care Entrée, Lipton, and Ferguson with the motivation of generating and executing a fast, user-friendly online system (Ferguson: col. 4, 18-20).

27. As per claim 26, the Care Entrée program teaches a system in which individuals pay a membership fee to the network provider to join the health care plan (page 3, paragraph 10) and participate via incentives within a member multi-level marketing network (page 2, paragraph 9). The Care Entrée program discloses a method in which anyone can pay a certain fee to join a health care plan.

The Care Entrée program fails to disclose an apparatus for providing a health care plan including a server, storage devices, communication interface, and a membership fee.

Lipton teaches a discount price list and a medical/service/good provider listing to the members that regulates the cost of goods/services to members by the medical service/good providers such that the members pay the service/good providers in-full directly for any services/goods rendered to the members based on the discount price list, and wherein the medical service/good provider listing comprises basic listing and premium listings for the medical service/good providers (Lipton: para. 7, 41-45, and 111).

Ferguson et al. teaches a system for providing a health care plan comprising a server (column 7, lines 42 - 47); one or more storage devices communicable coupled to the server, the one or more storage devices containing a discount price list that regulates the cost of goods/services provided to the members by a health care plan such that the members pay the network provider for any goods and/or services provided in full directly the discount price (column 7, lines 64 - 66); and a communications interface communicably coupled to the server that allows a member to access the discount price list (column 7, lines 48 - 50).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention to combine the teachings of Care Entrée, Lipton, and Ferguson with the motivation

of increasing accessibility and availability of the pharmaceutical listing and discount price list (Ferguson: col. 2, 7-9).

28. Claim 29 recites substantially similar limitations as those already addressed in claim 25, and, as such, are rejected for similar reasons as given above.

29. Claim 30 recites substantially similar limitations as those already addressed in claim 26, and, as such, are rejected for similar reasons as given above.

Response to Arguments

30. Applicant's arguments with respect to claims 2-26 and 28-30 have been considered but are moot in view of the new ground(s) of rejection.

Claims 24-26 and 28-30

31. Applicant submits that the cited references do not teach or suggest that "the Care Entrée program teaches....members...participate via incentives within a member multi-level marketing network" (p. 5, 5-7). Examiner disagrees. Applicant further states that there is no disclosure, teaching or suggestions of a multi-level marketing network where health care recipients or health care providers participate via incentives in any portion of Care Entree. Examiner states that Care Entree teaches a multi-level marketing network (i.e. networks of doctors and patients; p. 1, para. 2) where health care recipients or health care providers participate via incentives (i.e. doctors furnished drastic savings...Care Entree passes the same savings on to our members; p. 2, para. 9). Therefore, Care Entree teaches "...members...participate via incentives within a member multi-level marketing network."

32. Applicant argues that Care Entrée and Lipton do not teach or suggest "a discount price list regulating the cost of services/goods provided." Examiner disagrees. Care Entrée program is

a managed health care program which negotiates the cost of medical services or goods provided for individual members who have paid a membership fee, and provides a price list of services specific to a geographical location (Care Entrée: para. 47-48). Lipton, further, discloses a method in which PBM's represent groups (i.e. employers, HMO's). The difference between the Care Entrée and Lipton subject matter is that a PBM in the Care Entrée program collects fees and costs of medical procedures/pharmaceuticals from an individual, whereas Lipton collects from groups or organizations. The Goch reference is an article describing the Care Entrée program, and supports the Care Entrée reference. Since each element (collection of fees and costs of medical procedures/pharmaceuticals) and the function of the PBM are shown in the prior art, albeit shown as separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function, but in the very combination itself.

33. Applicant argues that Care Entrée, Lipton, and Ferguson do not teach “a method comprising basic and premium listings.” Examiner disagrees and provides support above. Applicant further argues that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to provide members with medical services or goods provided listing containing basic and premium listings of medical services/good providers. Examiner disagrees. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

1992). In this case, Ferguson teaches an online system in which members can search a directory (col. 4, 33-50), which Examiner interprets as a basic listing. The directory can include hyperlinks (i.e. the directory to premium listing) which would direct members to a web page containing advertisements and/or information regarding a particular medical service or good provider (col. 26, 8-24).

Conclusion

34. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEETAL R. RANGREJ whose telephone number is (571)270-1368. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SRR

/Robert Morgan/
Primary Examiner, Art Unit 3626